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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/209,280 12/11/98 JUNG

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EXAMINER

YOUNG, W

ART UNIT

PAPER NUMBER

2753

DATE MAILED:

08/31/99

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/209,280

Applicant(s)
Jung et al.

Examiner
W. R. Young

Group Art Unit
2753



☒ Responsive to communication(s) filed on 6/17/99

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 7-14 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 7-14 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2753

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 7-14 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Ostrover et al.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in view of any one of Ostrover et al., Kim, Silverman et al., Otsubo et al. '253, or Otsubo et al. '728 as applied in the last office action.

5. Applicant's arguments filed 6/17/99 have been fully considered but they are not persuasive.

In re page 2, second full paragraph, applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

In re page 2, bottom - page 3, top, Ostrover et al. clearly anticipates the claimed invention. Applicant has not cited any case law which supports the argument presented.

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In re page 3, first full paragraph, note on the front cover, "key matrix" USER INTERFACE 79. One of ordinary skill would expect that the reference to a USER INTERFACE typically suggests a keyboard (also see Ostrover, column 7, line 52). Further, note on the front cover, the presence of "audio" and "video" and a "demultiplexer" feeding separate audio and video buffers as controlled by a "master controller" which in turn is responsive to reproduced control information as is clearly shown by the input lines 77, 65 (also see Ostrover, column 7, lines 31-48, and figures 3-4). Further, note on the front cover, the abstract for disclosure of user selection of a soundtrack from multiple soundtracks.

In re page 4, second full paragraph, note the plurality of audio signals in the Table on page 3 of the specification, which are clearly separated since they are then input to audio presentation part 22 which uses STC/PTS to control presentation thereof.

In re pages 5-6, the secondary references plainly show selection between audio signals, e.g., see Silverman et al., column 2, lines 1-28, Kim, front cover, elements 30B-30D, 70, 30E, Otsubo et al. '728, front cover, elements 19-23, and Otsubo et al. '253, front cover, elements 19-23.

In re page 6, bottom - page 7, top, the applicant has not cited any case law which supports the assertion that the motivation for combining the references, "to provide a more pleasurable presentation to an end user" must be "in the references", per se, as opposed to an art recognized motivation self-evident to one of ordinary skill in the art by the mere presence of the noted references features. The generic art recognized motivation is deemed sufficient in light of the difference between the admitted art and the claimed invention and the nexus between the admitted art and the

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secondary references demonstrated by the similar art and the presence in all of a plurality of separated audio signals.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to W. R. Young whose telephone and VoiceMail number is (703) 308-1554. If a plurality of attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, A. Psitos, can be reached on (703) 308-1598.

The appropriate fax phone number for the organization (Group 2750) where this application or proceeding is assigned is (703) 308-9051.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.



Wayne R. Young
Primary Examiner
Art Unit 2753

wry
August 27, 1999